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| 09/639,825      | 08/17/2000  | Michael Chen         | AVI007              | 4926             |

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NAIPO (NORTH AMERICA INTERNATIONAL PATENT OFFICE)  
P.O. BOX 506  
MERRIFIELD, VA 22116

EXAMINER

GIBBS, HEATHER D

ART UNIT PAPER NUMBER

2622

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/639,825

Applicant(s)

CHEN, MICHAEL

Examiner

Heather D Gibbs

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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DETAILED ACTION

*Response to Amendment*

1. The amendment filed on 05/18/2004 has been entered and made of record.

Currently, claims 1-8 are pending.

*Response to Arguments*

2. Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant has amended the claims to clarify the scanner (master device) controls the operation of the slave portable external storage device for storing scanned images in the portable external storage device. Upon further consideration, the Examiner finds that Hayakawa teaches this limitation. Column 3 Lines 5-10, Hayakawa teaches that the image data can be communicated to a host without using a cord and the connector portion 4 enables the image scanner 1 to be used as a memory card capable of communicating information from one host to another or to be used as an extra memory for a host. The Examiner also points the applicant's attention to Col 4 Lines 8-22 where Hayakawa further teaches of the image scanner being a master device in that it controls the operation of the external storage device 21.

Additionally, applicant argues that Shih never teaches or suggests the electronic device in an external portable storage device. Upon further consideration of Shih, the Examiner finds this limitation to be suggested in Fig 4 and Column 2 Lines 29-51. Shih teaches of the scanner having external connections to the electric device 64, which is used

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for receiving transmitted data from the scanner 40. Hence, Shih also teaches of a scanner that directly transmits image data to an external portable storage device without the need of a host to control the image data transmission.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,4,5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayakawa (US 5,550,938).

Regarding claim 1, Hayakawa teaches of a scanner comprising: a casing 1a; a scanning module installed inside the casing for scanning a document and generating corresponding image data (Col 4 Lines 19-60); a control unit 52 installed in the casing 1a, the control unit 52 comprising at least a memory for storing a control program and the image data generated from the scanning module, and a processor 52 for executing the control program to control the operations of the scanner (Col 2 Lines 64-67 and Col 3 Lines 1-12); and an output port installed on the casing and electrically connected to the control unit for connecting a portable storage device disposed outside the casing of the scanner (Fig 11-connection with host computer) , wherein the scanner acts as a master device and treats

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the portable storage device as a slave device (Col 4 Lines 8-22); wherein when the scanning module finished scanning a document, the control unit converts the image data of the document according to the type of storage device that is connected to the output port and then transmits the image data converted by the control unit to the storage device (Col 3 Lines 43-55 and Fig 4).

Regarding claim 4, Hayakawa teaches wherein the scanner further comprises a connecting port installed on the casing and electrically connected to the control unit for connecting to a computer, and when the scanning module finished scanning the document, the control unit transmits the image data of the document to the computer for further processing via the connecting port (Col 3 Lines 43-55 and Fig 4).

Regarding claim 5, Hayakawa teaches wherein the portable storage device is a hard drive, or a floppy drive or a writ able optical drive (Col 3 Lines 43-55 and Fig 4).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-3,6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayakawa et al (US 5,550,938) in view of Shih (US 6,504,626).

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Considering claim 2, Hayakawa teaches of the scanner as disclosed above in claim 1 but fails to particularly point out wherein the output port is connected to a printer, and when the scanning module finishes scanning a document, the control unit prints out the image data of the document via the printer.

Shih discloses a scanner wherein the output port is connected to a printer, and when the scanning module finishes scanning a document, the control unit prints out the image data of the document via the printer (Col 3 Lines 9-26).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the output port of Shih in the scanner of Hayakawa. Hayakawa's scanner would easily be modified to include an output port for a printer since it already has features that support a connection with an external device.

Regarding claim 3, Hayakawa teaches of a scanner as discussed above wherein the control program first identifies the type of storage device connected to the output port, and then controls the transmission of the image data of the document according to the said type (Col 3 Lines 43-55).

The type of (storage) device is recognized when the scanner is inserted in the card insertion portion of disc driver 22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a driver for a printer. Hayakawa's scanner would easily be modified to include a control program that identifies the electronically connected printer.

Regarding claim 6, Hayakawa teaches of a scanner comprising: a casing 1a; a scanning module installed inside the casing for scanning a document and generating corresponding image data (Col 4 Lines 19-60); a control unit 52 installed in the casing 1a,

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the control unit 52 comprising at least a memory for storing a control program and the image data generated from the scanning module, and a processor 52 for executing the control program to control the operations of the scanner (Col 2 Lines 64-67 and Col 3 Lines 1-12); an output port installed on the casing and electrically connected to the control unit for connecting to an external portable storage device, wherein the scanner acts as a master device and treats the external portable storage device as a slave device (Fig 11-connection with host computer; Col 4 Lines 8-22); wherein when the scanning module finishes scanning a document, the control unit converts the image data of the document and then directly transmits the image data converted by the control unit to the storage device via the output port without the need of a host to control image data transmission, or converts the image data of the document and then transmits the image data converted by the control unit to the printer via the printer port for printing (Col 3 Lines 43-55 and Fig 4).

Hayakawa does not specifically teach of a printer port electrically connected to the control unit for connecting to an external printer and converting the image data of the document and then transmitting the image data converted by the control unit to the printer via the printer port for printing.

Shih discloses a scanner wherein the output port is connected to a printer, and when the scanning module finishes scanning a document, the control unit prints out the image data of the document via the printer (Col 3 Lines 9-26).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the output port of Shih in the scanner of Hayakawa. Hayakawa's scanner would easily be modified to include an output port for a printer since it already has features that support a connection with an external device.

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Regarding claim 7, Hayakawa teaches wherein the scanner further comprises a connecting port installed on the casing and electrically connected to the control unit for connecting to a computer, and when the scanning module finishes scanning the document, the control unit transmits the image data of the document to the computer for further processing via the connecting port (Col 3 Lines 43-55 and Fig 4).

Considering claim 8, Hayakawa teaches wherein the portable storage device 22 is a hard drive or a floppy drive or a writeable optical drive (Col 3 Lines 43-55 and Fig 4).

#### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather D Gibbs whose telephone number is 703-306-4152. The examiner can normally be reached on M-F 8AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Heather D Gibbs  
Examiner  
Art Unit 2622

hdg



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